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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/530,867	07/06/2000	RUDOLF RITTER	PM268772	7668

22850 7590 07/02/2004

OBLON, SPIVAK, MCCLELLAND, MAIER & NEUSTADT, P.C.
1940 DUKE STREET
ALEXANDRIA, VA 22314

EXAMINER

WRIGHT, NORMAN M

ART UNIT	PAPER NUMBER
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2134

DATE MAILED: 07/02/2004

12

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/530,867

Applicant(s)

RITTER ET AL.

Examiner

Norman M. Wright

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 26 June 2003.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-34 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-34 is/are rejected.
- 7) ☒ Claim(s) 8-18 is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.


NORMAN M. WRIGHT
PRIMARY EXAMINER

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date Z.

- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claims 11-18 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 8-18 are objected to under 37 CFR 1.75(c) as being in improper form because a multiple dependent claim can not refer back to a multiple dependent claim, or create a problem with respect to particularly pointing out and distinctly claiming the subject matter. See MPEP § 608.01(n). Accordingly, the claims have not been further treated in the merits.

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 1-7, and 19-34 are rejected under 35 U.S.C. 103(a) as being unpatentable EPO 0 786 915 A2, hereinafter '915, in view of WO 94/30023, hereinafter '023.
5. As to claims 1-5, 7, 19-24, 26-27, and 29-32, EPO '915 teaches a subscriber/mobile terminal identifying device having: an identification card, a

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subscriber, a mobile radio network/system, contact areas, mobile devices, memory means, id parameters, multiple networks, plural memories, multiple tables, plural accessing means, SIM server and messages, capabilities to transfer ids into memory, single table different table, single memory, multiple memories, determining multiple network accesses, communicating to external systems, different protocols/communication methods, encryptions/authentication keys, see (abs. et seq., figs. 1-10, 18-21B, pg. 2, pg. 3 lines 25 et seq., pg. 4, pg. 5 lines 5-18, pg. 6-8 et seq.). Not explicitly taught is utilizing the SIM in an environment that is not a radio network.

6. WO '023 teaches a telecommunication system and method of authentication wherein the systems are not restricted to communication within the environment of a radio network only. See abs., pg. 3, lines 3 et seq., pg. 9, lines 11 et seq., and pg. 10, lines 1-29. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of '915 with a means of utilizing SIMs in a environment that does not belong to a radio network. One of ordinary skill could have achieved this modification by utilizing the ADFPs or other programming means that would afford the SIMs the ability to communicate in different networks as disclosed by '023. It would have been obvious to one of ordinary skill in the art at the time of the invention to modify the invention of '915, a skilled artisan would have had a desire to utilize a SIM in a variety of networks, for the added benefits of increasing the flexibility, while still maintaining the security benefits it offers. And additionally because, by augmenting the invention of '915 with a means of being transportable to other networks,

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a person of ordinary skill in the art would greatly increase the ability to reconfigure the SIM, and attach additional services to the SIM in a easy and efficient manner.

7. As per claims 6, 25,28, and 33-34, not explicitly taught by either '915 or '023 is the use of induction coils/wireless, infrared devices and biometric identification data/devices. The examiner takes official notice of both the motivation and modification needed to provide a wireless, infrared or biometric interfaces/device. It would have been obvious to one of ordinary skill in the art at the time of the invention, to further modify the invention of '915 and '023 with the programming and/or device necessary to utilize wireless, biometric or infrared data/devices, because these devices are conventionally utilized computing networks. One of ordinary skill in the art would have been motivated to perform this modification, because, a person of ordinary skill in the art would have a desire to take advantage of the myriad ways of authenticating a user, as well as the pluralities or means of inputting and interfacing with computer systems. The use of infrared, wireless, and biometrics are all notoriously well-known means of having a user interface with a computer system.

Conclusion

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication should be directed to Norman M. Wright at telephone number (703) 305-9586.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Norman M. Wright whose telephone number is (703) 305-9586. The examiner can normally be reached on Mondays from 8am to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Greg Morse, can be reached on (703) 308-4789. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306. Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.


NORMAN M. WRIGHT
PRIMARY EXAMINER